

## **REMARKS**

Claims 1-24 and 36-40 are now pending in the application, and claims 25-35 have been cancelled without prejudice. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments contained herein.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-24 and 36-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ranney (U.S. Pat. No. 5,213,788) in view of Garibaldi et al (U.S. Pat. No. 6,364,823) and further view of Unger et al (U.S. Pat. No. 6,231,834). This rejection is respectfully traversed.

#### **Claim 1**

The Applicant agrees with the statement on page 4 of the Final Office Action, in that Ranney is deficient in disclosing different polymer structures as claimed.

The Applicant takes note with the statement on page 4 of the Office Action that Garibaldi discloses embolic compositions, and the use of long chain polymers. **Garibaldi only discloses** a precipitating polymer having a solvent that dissolves a polymer to yield **a solution in which paramagnetic particles are suspended**. (Garibaldi, col. 3, line 58 - col. 4 line 4). A solution surrounding a paramagnetic particle is not the same as (or anticipatory of) magnetically responsive particles comprising a core and a layer around the core sufficiently thick to give the particles a diameter between 20nm and 40 nm. A solution surrounding a paramagnetic particle cannot inherently include such a layer of sufficient thickness, without some indication that the claimed feature would invariably result. The mere fact that a thing is possible does not render the thing

Moreover, the Applicant submits the layer of claim 1 is not obvious in view of the teachings in Garibaldi, because Garibaldi does not teach an embolic material in which the precipitating polymer that surrounds the paramagnetic particles may be cleaved to permit the paramagnetic particles to be dispersed through the blood and excreted downstream. Rather, Garibaldi teaches that as the solvent dissipates into the blood, the polymer precipitates and adheres to the vessel wall, and the paramagnetic material becomes less magnetically responsive over time so that the embolic does not interfere with or restrict subsequent magnetic procedures. Thus, absent some teaching or motivation in Garibaldi to provide a hydrophobic outer layer that is removable, the presently claimed embolic material would not be obvious in view of Garibaldi.

With regard to Unger, the Applicant submits the layer of claim 1 is not obvious in view of the teachings in Unger, because Unger is absent some motivation or teaching of a layer having an outer portion including a hydrophobic outer chain that is removable. While Unger teaches a linking group that comprises a hydrophilic polymer, and that amine groups present on a backbone of a polymer may be coupled to a hydrophilic layer, Unger does not teach or suggest a layer of which an outer portion includes hydrophobic polymer chains that are removable. Thus, the Applicant submits that claim 1 is distinguished over these references,

Contrary to the teachings in Garibaldi or Ranney, claim 1 teaches a layer in which an outer portion of the coating includes hydrophobic polymer chains. The presently claimed coating has an outer portion including a hydrophobic polymer chain that may be cleaved or degraded to yield a hydrophilically-coated magnetic particle,

which may then be removed by renal excretion, for example. (See paragraph 0052 of the presently published patent application 20040157082).

The hydrophobic portion is on the outside of the coated particle when attached to the magnetic core, and as such 'camouflages' the particle such that the coated particle initially display hydrophobic properties. At a subsequent point, the hydrophobic polymer portion may be cleaved from the coating, to separate the magnetically responsive particle with hydrophilic functionality. (See paragraph 0052 of the presently published patent application 20040157082).

Thus, the Applicant submits that claim 1 is not obvious in view of the cited references, because the references lack any suggestion or teaching of a layer having an outer portion including a hydrophobic outer chain that is removable. As such, the Applicant submits that claim 1 is allowable over the cited references.

With regard to claims 2-5, 8 and 18-21, these claims ultimately depend from independent base claim 1, which the Applicant believes to be allowable in view of the above remarks. As such, the Applicant submits that claims 2-5, 8 and 18-21, by virtue of their dependence from claim 1, are also allowable for at least these reasons.

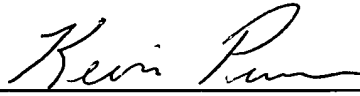
## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and

favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

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